

REMARKS

Claims 1-19, 21-30, 32-37 and 41-45 are pending in the application with claims 1, 21-24, 34-35 and 37 being independent.

Claims 22, 23, 33, 35 and 36 are rejected under 35 U.S.C. §112.

Claims 1-19, 21-30, 32-37 and 41-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Weare et al. (US Patent 7,065,416, hereinafter Weare) in view of McEachern (US Patent 5,615,302, hereinafter McEachern) and further in view of Logan et al. (US Patent 6,633,845, hereinafter Logan).

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an

independent claim has been rewriting to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Rejection Under 35 U.S.C. §112

Claim 33

Claim 33 is rejected under 35 U.S.C. §112, ¶2, the Examiner stating that the limitation “said repetition” in lines 2 and 3 lacks antecedent basis.

Claim 33 is amended to recite “a repetition,” thereby curing the lack of antecedent basis. Therefore, Applicants’ claim 33 is patentable under 35 U.S.C. §112, ¶2. Applicants respectfully request the Examiner withdraw the rejection.

Claims 22, 23, 35 and 376

Claims 22, 23, 35 and 36 are rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement.

As articulated in MPEP §2163.04, when basing a rejection on the failure of the applicant’s disclosure to meet the written description requirement of the first paragraph of 35 U.S.C. §112, USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure. The Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.

The Examiner simply stated that “The invention, as described in the specification, page 7, and Figs. 1-6, does not show any means for grouping the coefficient of the second representation; means for searching a database for substantially matching segments; and means for determining whether said subsequent media program subset exhibits similarities to said initial media program subset.” The Examiner listed the limitations of the claims, however, did not present any evidence let alone presenting evidence by a preponderance to establish a reasonable basis for questioning the adequacy of the disclosure. The Examiner must set forth express findings of fact which support the lack of written description conclusion. See MPEP §2163.04(I). Consequently, the Examiner

failed to support the rejection as required by the rules. The rejection is traversed and withdrawal of same is respectfully requested. Therefore, Applicants' claims 22, 23, 35 and 36 are patentable under 35 U.S.C. §112. ¶1.

Rejection Under 35 U.S.C. §103

Claims 1-19, 21-30, 32-37 and 41-45

Claims 1-19, 21-30, 32-37 and 41-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Weare in view of McEachern and further in view of Logan. The rejection is respectfully traversed.

The Examiner cites col. 5:15-22 of Weare for teaching the claimed feature: "for each of at least two media program subsets, performing the steps of:" The cited passage is reproduced here for ease of comparison.

Such a system and methods may be useful for the indexing of a database or other storage collection of media entities, such as media entities that are audio files, or have portions that are audio files. The methods also help to determine media entities that have similar, or dissimilar as a request may indicate, melodic movement by utilizing classification chain techniques that test distances between media entities in terms of their properties. col. 5:15-22.

As can be seen, the passage on its face does not teach or fairly suggest the claimed feature. The above feature specifically claims at least two subsets of a media program. In rejecting the claimed limitation, the Examiner made no comments whatsoever. In such cases when the Examiner does not comment when mapping a claimed feature to a passage of the prior art, it can reasonably be assumed that the passage teaches the claimed feature on its face and that no interpretation is required. However, the passage on its face fails to teach the claimed feature. If the passage is equivalent to the claimed feature, the Examiner should so state. A prima facie case of equivalence is nonexistent in this case, because there is no factual basis to support the conclusion that these two elements at issue are equivalent. (See MPEP §2184 (II)). The Examiner did not provide any explanation and rationale as to why the prior art element would be an equivalent as is required under those circumstances. (See MPEP §2183). Accordingly, the Examiner fails to establish a prima facie case of obviousness. Withdrawal of the rejection is respectfully requested.

Regarding claim 21, the Examiner alleges that Logan et al. at col. 5, lines 4-35 and col. 6, lines 53-56) teach the claimed features: “grouping ones of said coefficients of said second representation to form segments; storing at least 30 minutes worth of segments; and selecting a plurality of said segments.” However, with reference to the cited passages, Applicants could not discern any reference that fairly suggests the above recitations. It appears the Examiner does not accord any patentable weight to the phrases “grouping ones of said coefficients of said second representation” and “storing at least 30 minutes” within the context of the claims. All words in a claim must be considered in judging the patentability of that claim against the prior art. See MPEP §2143.03. One cannot divine claim meaning in a vacuum. Philips v. AWH Corporation (Fed. Cir. July 12, 2005).

Based on the above, neither Weare, McEachern nor Logan combined or alone disclose, teach or fairly suggest “grouping ones of said coefficients of said second representation to form segments; storing at least 30 minutes worth of segments; and selecting a plurality of said segments.” To establish a prima facie case of obviousness under 35 U.S.C. §103(a) based upon a combination of references, the cited combination of references must disclose, teach or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881(C.C.P.A. 1981). All of the claimed features of independent claims 21, 22, 23 and 24 are not taught or suggested by the combination of Weare, McEachern and Logan or by either reference alone. Accordingly, the Examiner fails to establish a prima facie case of obviousness with respect to claims 21, 22, 23 and 24. Withdrawal of the rejection is respectfully requested.

Independent claims 24, 34-35 and 37 recite relevant limitations similar to those recited in independent claims 1 and 21-23. As such, these independent claims also are patentable under 35 U.S.C. §103(a) over Weare in view of McEachern, and further in view of Logan. Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also patentable under 35 U.S.C. §103(a) over Weare in view of McEachern, and further in view of Logan.

Therefore, Applicants' claims 1-4, 6-16, 18, 21-23, 37 and 41-45 are patentable under 35 U.S.C. 103(a) over Weare in view of McEachern. Applicants respectfully request the Examiner withdraw the rejection.

Conclusion

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 842-8110 X120 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

Dated: 5/28/09



Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

WALL & TONG, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-842-8110
Facsimile: 732-842-8388